

**RESPONSE AND REQUEST FOR RECONSIDERATION**

In response to the Office Action of May 12, 2009 Applicants hereby request the Examiner to reconsider the claims in view of the present amendments and remarks.

The Amendments

Applicants have amended independent claim 1 to specify  $R^2$  to be a hydroxyl group. The definition of  $R^2$  has been amended to remove reference to a hydrocarbyl group. The amendment is fully supported by the application as filed by claim 7, and also page 8 line 4.

Claim 36 has also been cancelled.

It is submitted that the amendments described above are fully supported by the application and do not add subject-matter.

Remarks

The Examiner has raised a 35 U.S.C. 102(b) rejection to claims 1-5, 31-34, 36 and 37 in view of Habeeb (US 5,330,666). In particular, the Examiner has highlighted the situation when in the formula as defined by the present invention  $R^3$  is hydrogen, U is a hydroxyl group,  $R^2$  is a hydrocarbyl group and j is 1. In view of the amendment described above, claim 1 specifies  $R^2$  to be a hydroxyl group. Since  $R^2$  no longer overlaps with the hydrocarbyl group as noted by the examiner, it is believed that the present claim 1 is novel over Habeeb.

Since claims 2-5, 31 to 34 and 37 all specify the subject matter of claim 1 these claims are also novel over Habeeb.

Accordingly, it is submitted that all pending claims are novel over Habeeb. The Examiner is therefore respectfully requested to withdraw the 35 U.S.C. 102(b) rejection and find all pending claims novel.

With regard to unobviousness, it is submitted that amended claim 1 is unobvious over Habeeb in view of the remarks and reasoned statements.

Habeeb discloses a lubricating composition containing a hydrocarbylsalicylic acid and an alkoxylated amine salt thereof (see column 1, line 47 to column 2, line 1). The amine salt may be derived from ethoxylated amines (see column 3, lines 1 to 11). In contrast the present invention has a sulphur-free reaction product that has two distinct groups. The first group may be derived from salicylic acid (i.e., see formula I or formula III of the Applicant's claim 1) and the second group may be derived from a substituted phenol (i.e., see formula II or formula IV of Applicant's claim 1).

In addition, the organic nitrogen base as defined by Applicant's claim 1 is at least one member selected from the group consisting of (1) an amino-containing imine or a reactive equivalent thereof; (2) ammonia or a reactive equivalent thereof; (3) a monoamine; (4) a polyamine; (5) a nitrogen containing heterocycle; (6) an aminoalcohol; (7) a tetraalkylammonium salt; and (8) a non-heterocyclic aromatic amine.

These amines are distinct from the alkoxyated amine of Habeeb. Thus there are a number of differences between the present invention and Habeeb. Even if a person of ordinary skill in the art were to combine Habeeb with Sougawa or Hoke as has been suggested by the Examiner in relation to claims 21, 23 and 25-30, the result would not be present invention. The reason is because neither Habeeb, nor Sougawa nor Hoke disclose a product as defined by formula (I) to (IV) as is presently claimed.

In addition, as is noted in the application as filed there is data that demonstrates the unobviousness of the present invention over Habeeb. Example 7 as filed can be considered to be representative of Habeeb to the extent that it discloses an example with an alkyl salicylate. The alkyl salicylate of example 7 has been salted with an amine of the present invention, specifically triethanolamine.

Examples 6 and 8 to 10 as described in the application as filed specify different permutations that are defined by feature U described in formula (I) and (III) of the present invention. The only difference between examples 6 and 8 to 10 and example 8 is the nature of the carboxylic acid described in formula (I) and (III) (see pages 21 and 22 of the application as filed). The amine used in the reaction is triethanolamine in all cases. The products formed in examples 6 to 10 were evaluated for wear performance by a programmed temperature high frequency reciprocating rig (see page 24 of the application as filed). The data obtained is as follows (extract taken directly from the table on page 25 of the application as filed):

Example	Wear Scar ( $\mu\text{m}$ )	Film Formation
Lubricating Oil Composition Example 6	193	6
Lubricating Oil Composition Example 7	219	2
Lubricating Oil Composition Example 8	207	6
Lubricating Oil Composition Example 9	181	13
Lubricating Oil Composition Example 10	175	20

The data demonstrates that the alkyl salicylic acid amine salt with triethanolamine has a wear scar of 219  $\mu\text{m}$ . This material has a similar alkyl salicylic acid structure as Habeeb. In contrast, products of the present invention have a wear scar in the range of 175 to 207  $\mu\text{m}$ . This reduction in wear constitutes an unexpected reduction in wear compared to the alkyl salicylic acid amine salt. The wear reduction would not have been expected by a person of ordinary skill in the art because there is no teaching or suggestion from Habeeb alluding to such an improved performance.

In addition to the data described above, it also noted that examples 1 to 5 and 11 to 13 of the present invention have even better results in terms of wear reduction compared with an alkyl salicylic acid amine salt. The wear scars measured range from 141 to 178  $\mu\text{m}$ . These are all lower than the 219  $\mu\text{m}$  recorded for the alkyl salicylic acid amine salt. Thus the present invention has demonstrated that a wide variety of amines specified by the present claims and possible compounds derivable from formula (I) to (IV) have improved wear performance over an alkyl salicylic acid amine salt. Accordingly, it is submitted that the scope of the pending claims is commensurate with the scope of the performance advantage noted by invention.

In view of the remarks above, it is submitted that amended claim 1 and all dependent claims specifying the subject matter of claim 1 are also unobvious.

The Examiner has made two 35 U.S.C. 103(a) rejections as follows:

Claims 21 and 23 over Habeeb in view of Sougawa (US 6,147,035); and

Claims 25-30 over Habeeb in view of Hoke (US 4,090,971).

Given that the amendments described above do not specify the subject matter of claims 21, 23 or 25 to 30 it is submitted that these obviousness rejections are obviated because all the claims specify the subject-matter of unobvious claim 1. Accordingly, the Examiner is respectfully requested to withdraw the 35 U.S.C. 103(a) rejections to claims 21, 23 or 25 to 30.

In view of the remarks above, it is submitted that all pending claims meet the requirements of 35 U.S.C. 102(b) and 103(a). Accordingly, all pending claims may be considered novel and are unobvious. The Examiner is therefore requested to reconsider the rejections and ultimately withdraw them thereby allowing all pending claims.

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Any additional required fees, or any insufficiency or overpayment of fees, should be charged or credited to deposit account 12-2275 (The Lubrizol Corporation).

Respectfully submitted,

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